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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,353	10/07/2005	Tatsuya Inoue	043890-0763	9282

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MCDERMOTT WILL & EMERY LLP
600 13TH STREET, NW
WASHINGTON, DC 20005-3096

EXAMINER

LEJA, RONALD W

ART UNIT	PAPER NUMBER
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2836

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/552,353

Applicant(s)

INOUE ET AL.

Examiner

Ronald W. Leja

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/7/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over (JP 58-85502).

(JP 58-85502) discloses a varistor having an insulating substrate made of alumina (5), an internal electrode (6a), a varistor layer (3) and an external electrode (6b) and a protective film (8) (for Claim 5). It does not appear to disclose at least a pair of external electrodes in addition to the one internal electrode (6a) and external electrode (6b) and a specific thickness for Claim 3. However, it is the opinion of the Examiner, that it would have been obvious to include as many external electrodes as deemed necessary for the particular application-at-hand so as to allow the varistor to be inserted into the circuit and perform as intended. Secondly, duplicating parts only involves routine skill in the art. As far as thickness, the Reference discloses that the

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varistor unit is considered a thick-film varistor and it is the opinion of the Examiner that it would have been obvious to have the insulating substrate two or more times as thick as the varistor so as to offer a degree of rigidity and thermal sinking qualities to the design, thereby leading to increased durability and increased protection to the varistor when shunting currents, by allowing for generated heat diffusion thru the insulating substrate.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over (JP 58-85502) in view of (JP 07-33514).

Claim 4 adds that the insulating substrate is alumina and has copper oxide of 0.1% or less by weight ratio. (JP 58-85502) discloses the ceramic insulating substrate to be alumina, but does not appear to disclose the use of copper. However, (JP 07-33514) teaches an alumina insulating substrate composed of greater than 99.9% alumina. It would have been obvious to utilize an alumina ceramic insulating substrate having greater than 99.9% alumina for the high anti-bending strength and high thermal conductivity, thereby increasing protection to the varistor unit. The use of copper would have been obvious as a means to increase thermal conductivity.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over (JP 58-85502) in view of Azumi et al. (5,034,709).

Claims 6-8 are drawn to the use of a built-in inductor and formation of "Pi" shaped and multi-stage filters. Azumi et al. teach the fabrication of varistors in combination with inductors upon the same ceramic substrate so as to form filter circuits (see Figs 3 & 5). It is the opinion of the Examiner that it would have been obvious to include other components, such as, inductors, so as to not only shunt


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surges, but to filter signals as well, thereby increasing application of the ceramic device to those applications further requiring a filtered clean signal.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald W. Leja whose telephone number is (571)272-2053. The examiner can normally be reached on Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on (571)272-2800. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Ronald W. Leja
Primary Examiner
Art Unit 2836

rwl
March 18, 2007

